



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/400,170 | 09/21/1999 | BRIAN R. MCCARTHY | 310048-480 | 3096 |

7590 05/21/2003

DOUGLAS N LARSON
OPPENHEIMER WOLFF & DONNELLY
2029 CENTURY PARK EAST SUITE 3800
LOS ANGELES, CA 90067

EXAMINER

GRAY, LINDA LAMEY

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1734

DATE MAILED: 05/21/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/400,170

Applicant(s)

MCCARTHY ET AL.

Examiner

Linda L Gray

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-56 and 65-141 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43-56 and 65-96 is/are allowed.
- 6) ☒ Claim(s) 97-118, 121-138, 140 and 141 is/are rejected.
- 7) ☒ Claim(s) 119, 120 and 139 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Detailed Action

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. **Claims 97-98, 108-110, 113-116, 118, 121-123, 127-128, 132-133, 135-136, and 141 are rejected under 35 U.S.C. 102(b) as being anticipated by Klein (US 5,198,275).**

Claim 97, Klein teaches a method of forming printable media (Fig 3) including providing a construction including **(a)** printable facestock 85, **(b)** liner 90 having liner coating 125, and **(c)** adhesive 95 between facestock 85 and coating 125 and thereby adhering liner 90 to facestock 85. The method further includes cutting through facestock 85 to liner 90 to form facestock cut lines 200 defining at least in part perimeters of printable media whose back sides are formed by a back side of facestock 85 (c 2, L 39, to c 4, L 24).

Claim 98, facestock 85 is cardstock. **Claims 108-109**, the cardstock can be cut into individual sheets after lines 200 are formed with a plurality of printable media per sheet (**claim 116**). **Claim 110**, facestock 85 is a sheet and lines 200 include horizontal cut lines that extend a full width of the sheet. **Claim 113**, there is provided a matrix of business cards including a pair of directly adjacent columns and a plurality of rows. **Claim 114**, the printable media are in a central portion surrounded by a facestock waste frame. **Claim 115**, the drawings indicate the printable media to be rectangular. **Claim 118**, Klein teaches cutting through an outer face of liner 90 to define a plurality of strips on the back side of facestock 85. **Claim 121**, the strips extend horizontally on facestock 85. **Claim 122**, the printable media each include a single piece card. **Claim 123**, in Klein liner 90 covers the backside of facestock 85's lines 200 and hole the media together for a printing operation of the media and allow the media to be removed form liner 90 after printing. **Claim 127**, in Klein facestock 83 is a sheet and one of lines 200 is horizontal and extends the full width of the sheet. **Claim 128**, in Klein liner 90 extends the entire length of facestock 85. **Claim 132**,

lines 200 are vertical and horizontal. **Claim 133**, facestock 85 is a sheet and lines 200 extend horizontally the full width of the sheet. **Claim 135**, liner 90 covers all the backside of lines 200. **Claim 136**, facestock 85 includes a cardstock sheet, and liner 90 is a paper sheet. **Claim 141**, cut lines 200 do not penetrate liner 90.

Claim Rejections - 35 USC § 103

3. Claims 99-105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein in view of Cahill et al. (US 5,766,398).

Claims 99-101, Klein does not teach a printer receptive top coating (claim 99) of a laser color-optimizing coating (claim 100) or an ink-jet color optimizing coating (claim 101).

Cahill et al. teach continuously printing image 18 onto plastic film 14 having coating 16 thereon (c 1, L 29-40; c 2, L 25-44; c 4, L 1-9; c 5, L 1-37; c 7, L 43-44). Coating 16 is a PVA solution intended to be very receptive to the ink of image 18 (c 4, L 4; c 5, L 39, to c 7, L 4).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Klein coating a PVA solution on facestock 85 to receive the print because Cahill et al. teach using such is intended to be very receptive to ink being printed thereon where laser printing and ink jet printing are conventional in the card making art.

Claim 102, the construction is made of paper layers. **Claim 103**, the construction is a non-dry laminate construction.

Claims 104 and 105, Klein does not teach a liner primer of polyvinyl alcohol with silicate.

However, liner primers are conventional in the art to prepare the liner for contact with another surface, and for this reason it would have been obvious to a person of

ordinary skill in the art at the time the invention was made to have provided in Klein a liner primer on liner 90 of polyvinyl alcohol base with silicate.

4. Claim 106 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klein in view of Mallya et al. (US 5,656,705).

Claim 106, Klein does not teach adhesive 95 to be a water-base acrylic suspension polymer.

Mallya et al. teach this adhesive, i.e. a water-bases acrylic suspension polymer adhesive, is conventionally used in to production of repositionable labels (c 1, L 1-6).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Klein that adhesive 95 is a water-based acrylic suspension polymer because Mallya et al. teach this adhesive, i.e. a water-bases acrylic suspension polymer adhesive, is conventionally used in to production of repositionable labels and it is obvious to place one adhesive with another art recognized alternative adhesive used in the same art.

5. Claim 107, 111-112, 117, 129-131, 134, 137-138, and 140 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein.

Claim 107 Klein does not teach a base coat on facestock 85 between facestock 85 and adhesive 95.

It is conventional to provide an adhesive receptive coating on a web before and adhesive is applied to promote a stronger hold of the adhesive and the web during production, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Klein an adhesive receptive base coat between facestock 85 and adhesive 95.

Claims 111 and 137, Klein does not teach unwinding from a roll.

It is conventional to provide a supply of label material from a roll because such is an efficient means for storing a large quantity of material, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Klein unwinding from a roll.

Claim 112, in Klein the construction is a sheet construction, liner 90 is a sheet, and facestock 85 is a sheet.

Claim 117, *Klein does not teach specifics about the cutting of lines 200 in that Klein does not teach that cutting is die cutting.*

Die cutting is conventional in the art, and it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Klein that cutting lines 200 is by die cutting because it is obvious replace one type of cutting with another art recognized alternative type of cutting.

Claims 129-130, *in Klein the construction in a dual-web. Klein does not teach cutting the finished construction into two webs longitudinally.*

However, it is conventional to cut a web having a plurality of labels thereon into more than one web by cutting such longitudinally, and it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Klein cutting the construction into two webs longitudinally.

Claim 131, *Klein does not teach calendaring for cutting.*

It is known to calender an endless web to keep tension within the web, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Klein calendaring the continuous cardstock for cutting.

Claim 134, *Klein does not teach that the rest of horizontal lines 200 are spaced inwardly with the edges.*

It is conventional to provide a small uncut piece of web material and the edges of a group of labels in a sheet to further help keep the labels together until desired to be separated, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Klein that the rest of horizontal lines 200 are spaced inwardly from the edges.

Claim 138, Klein teaches cutting through an outer face of liner 90 to define a plurality of strips on the back side of facestock 85.

Claim 140, Klein does not teach printing before cutting.

However, MPEP § 2144.04 ("Changes in Sequence of Adding Ingredients") indicates that a particular order (i.e., printing before cutting) is prima facie obvious in the absence of new or unexpected results

6. Claims 124-126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein in view of Popat et al. (US 5,407,718).

Claims 124-125, Klein does not teach that liner 90 is a solid liner.

Popat et al. teach a plurality of printable media 22 on solid liner 28.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Klein that liner 90 is a solid liner without the cut lines because Popat et al. teach solid liners to be conventional when individual cards are not desired to be separated completely from the construction and one skilled in the art not wishing to have a completely separated piece from the construction of Klein would have been motivated to eliminate cut lines 300 to provide a solid liner in that Popat et al. provide the necessary guidance for using solid liners in the printable media art.

Claim 126, facestock 85 is a sheet and liner 100 are horizontal and extend a full width of the sheet.

Allowable Subject Matter

7. Claims 43-56 and 65-96 allowed.

Claims 119, and thus claim 120, and claim 139 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in

independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: **claim 119**, Klein does not teach removing some of the strips from facestock 85; and, **claim 139**, in Klein the printable media do not define a matrix of rectangular business cards including a plurality of rows and columns of the cards with the cards of each directly abutting cards of adjacent rows and columns separated only by lines 200 in that there is waste web of facestock 85 therebetween.

9. As allowable subject matter has been indicated, Applicants' reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Amendment

10. Applicants' comments filed 2-26-03 have been fully considered.

Conclusion

11. Applicants' amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this or earlier communications should be directed Linda L. Gray at 703-308-1093, 6:30am-4:00pm, M-F. The examiner's supervisor, Richard Crispino, can be reached on 703-308-3853. Any general inquiries should be directed to

Art Unit 1734

the receptionist at 703-308-0661. The fax numbers are 703-305-7718 (before final) and 703-872-9311 (after final).

llg

May 19, 2003

Linda P. Gray
LINDA GRAY
PRIMARY EXAMINER